# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

James R. Durkee et al.

Serial No.: 09/848,581

Filed: May 3, 2001

For: INTERACTIVE TELEVISION NETWORK AND METHOD INCLUDING CONTENT SEARCHING

Attorney Docket No.: 2000-0617

Group Art Unit: 2614

Examiner: Jade O. Laye

## APPEAL BRIEF UNDER 37 C.F.R. § 41.37
## AND PETITION FOR EXTENSION OF TIME
## UNDER 37 C.F.R. § 1.136(a)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief from the final rejection of claims 1-27 of the Office

Action mailed on April 25, 2005 for the above-identified patent application.

Appellants hereby petition for a two month extension of time to file the Appeal

Brief based on the Notice of Appeal filed in response to the final Office Action mailed April

25, 2005, thereby extending the time period within which to respond to November 25, 2005.

12/16/2005 DEHMANU1 00000005 09848581

01 FC:1402                          500.00 OP
02 FC:1252                          450.00 OP

## I. REAL PARTY IN INTEREST

The real party in interest is AT&T Broadband, LLC ("Assignee"), a corporation organized and existing under the laws of the state of Delaware, and having a place of business at 188 Inverness Drive West, Englewood, CO 80122, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on January 23, 2003 at Reel 013670/Frame 0398. Subsequent to this assignment, AT&T Broadband, LLC has been acquired by Comcast Cable Communications, Inc., however no assignment reflecting these name changes with respect to the present application is known to have been recorded.

## II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to the Appellants, the Appellants' legal representative, or the Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## III. STATUS OF CLAIMS

Claims 1-27 are pending in this application. Claims 1-27 have been rejected and are the subject of this appeal.

## IV. STATUS OF AMENDMENTS

No amendments after final rejection have been filed.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

Each of the pending independent claims (1, 8, 9, and 19) generally relate to interactive television systems and retrieving data from remotely located interactive television network components, i.e. network components not associated with a headend (broadcast signal source). The present invention is different from the prior art in that it relates to the use of a

data locator (or similar feature) to retrieve the remotely located data. (page 6-7, lines 20-3, Figure 1)

The data collector is associated with the television headend such that the headend is able to communicate the remotely located data over the same communication medium on which broadcast television signals are provided. (page 7, lines 3-10, Figure 1)

As recited in independent claim 1, 8, and 9, at least a portion of the remotely located data is associated with interactive television network components. (page 8, lines 3-10, Figure 1) This allows the STTs to access both broadcast television signals and interactive television signals and data. (page 1, lines 25-26)

As recited in independent claim 19, a bug is associated with a network address and delivered to the STT in a broadcast stream. The STT displays the bug such that the user can selected it for retrieving data from a remotely located network component associated with the specified network address. (page 18, lines 1-12, Figures 8-9)

## VI.  GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.     Claims 1-4, 8-14, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 5,751,282 to Girard (hereinafter the Girard patent) in view of USPA 2002/0112007 to Wood (hereinafter the Wood application);

2.     Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Girard patent in view of the Wood application and further in view of USPN 5,589,892 to Knee (hereinafter the Knee patent);

3.    Claims 7 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Girard patent in view of the Wood application and further in view of USPA 2001/0016947 to Nishikawa (hereinafter the Nishikawa application);

4.    Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Girard patent in view of the Wood application and further in view of USPN 6,642,939 to Vallone (hereinafter the Vallone patent);

5.    Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Girard patent in view of the Wood application and further in view of USPN 5,606,374 to Bertram (hereinafter the Bertram patent);

6.    Claims 19-21 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,182,287 to Schneidewend (hereinafter the Schneidewend patent) in view of the Bertram patent and further in view of USPA 2001/0030959 to Ozawa (hereinafter the Ozawa application); and

7.    Claims 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schneidewend patent in view of the Bertram patent and the Ozawa application and further in view of the Nishikawa patent.

## VII. ARGUMENT

**A.    Claims 1-4, 8-14, and 16 Are Patentable Under 35 U.S.C. § 103(a)
Over The Girard Patent and The Wood Application**

Claims 1-4, 8-14, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Girard patent and the Wood application. This rejection applies to

independent claims 1, 8, and 9, and dependent claims 2-4, 10-14, and 16. The Appellants respectfully submit that there is no motivation to combine the cited references and that even the improper combination thereof still fails to teach each element recited in the independent claims.

Independent claims 1, 8, and 9 include limitations directed towards a data locator configured for accessing data from remotely located interactive television network components and providing broadcast programming. A set-top terminal (STT) is in communication with the data locator to interface the data and broadcast programming with the a subscriber.

As noted by the Examiner, the Girard patent "fails to teach whether the system can interact with other network components," such as the remotely located interactive television network components. (Page 6 of the final Office Action) The ability of the data locator to communicate with remotely located databases is critical to the claimed invention. To make up for the deficiencies of the Girard patent, the Examiner relies upon the teachings of the Wood application.

The Examiner's reliance on the Wood application is inappropriate as there is no motivation to combine the teachings of Wood with the teachings of Girard. MPEP 2143 states:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be **some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or **to combine reference teachings**. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The teaching or suggestion to make the claimed combination and

the reasonable expectation of success **must both be found in the prior art, not in applicant's disclosure**. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Neither of the cited references provide any motivation to combine the teachings thereof. The Girard patent relates to VOD and coordinating delivery of VOD content to a subscriber as a function of whether the desired content is associated with a past, current, or future programming. The Wood application relates to message management and providing a computer accessible webpage for a subscriber to review messages retrieved from multiple message sources.

The Girard patent cannot provide any motivation to include the teachings of the Wood application because the Girard patent has no desire to collect messages from multiple sources and then to organize the collected messages for subscriber access - it is only concerned with providing VOD to the subscriber. The Wood application cannot provide motivation to include the teachings of the Girard patent because it has nothing to do with VOD and/or the delivery of VOD – it is only concerned with compiling messages from different message sources.

As noted above, there must be some suggestion or motivation to combine the teachings of the cited references and that suggestion or motivation cannot be found solely in the Appellants' application. The Examiner has failed to sufficiently point out any such suggestion or motivation, absent that provided by the Appellants' application.

The Wood application, at paragraph 21, mentions "WebTV." This reference is made to suggest retrieving messages from a "WebTV" source. The Examiner submits that this single reference to television is sufficient to imply the obviousness of combining the message retrieval of Wood with the VOD of Girard. One of ordinary skill in the art would not logically determine that this reference to "WebTV" would necessarily imply that the Wood

message retrieval and management system could be integrated into the VOD delivery system of the Girard patent, as suggested by the Examiner.

As noted in the Appellants' background section, the use of "WebTV" is known. (page 1, lines 24-26) However, as further noted, "WebTV" fails to permit users to access resources within a cable (television) network, i.e., access to the claimed interactive television network components and data stored thereon. This implies that one having ordinary skill in the art would not find it obvious to combine the Wood messaging system with the Girard VOD system based solely on a reference to retrieving messages from "WebTV" as "WebTV" does not permit access to VOD and other interactive television services and systems.

Accordingly, the Appellants submit that the Examiner has improperly combined the teachings of the Wood application and Girard patent.

Nonetheless, even the improper combination thereof fails to teach the claimed invention. As noted above, independent claims 1, 8, and 9 include limitations directed towards a data locator configured for accessing data from remotely located interactive television network components and providing broadcast programming. A set-top terminal (STT) is in communication with the data locator to interface the data and broadcast programming with the a subscriber.

As noted by the Examiner, the Girard patent "fails to teach whether the system can interact with other network components," such as the remotely located interactive television network components recited in claims 1, 8, and 9. (Page 6 of the final Office Action) To make up for the deficiencies of the Girard patent, the Examiner relies upon the teachings of the Wood application to suggest including remote communication capabilities with the Girard VOD system.

The Wood application merely relates to a system for storing messages on a message database so that a user can access the messages from a network device having capabilities to communicate with the message database, i.e. from a computer connection to a webpage. Importantly, the Wood application fails to disclose any device capable of broadcasting programming to subscribers, let alone a device for both broadcasting programming and locating data on remote network components. The Examiner submits that the Wood application need not teach such a dual purpose feature. The Appellants submit that the Wood application must at least provide a teaching that its system is compatible with a broadcasting system in order to teach changing the Girard VOD system to include the Wood messaging system.

The Appellants respectfully submit that the mere capability of the Wood application to store messages from different message recording devices is insufficient to suggest changing the operation of the Girard VOD system to include capabilities for collecting messages from remote network components and communicating those messages over the same medium as the VOD, as suggested by the Examiner. At best, the Wood application merely teaches an independent delivery system for VOD and message management, such as webpage for accessing the messages through a communication medium separate from the VOD system. This is different from the Appellants' claimed data locator that provides both of the broadcast programming and access to the network components.

As noted in the Appellants' background section, such independent delivery systems are precisely overcome by the claimed invention, i.e., the present invention allows subscribers to access broadcast programming and interactive television components from the same data locator, as opposed to the separate communication mediums suggested by Wood and Girard. (page 1, lines 16-26)

For the foregoing reasons, the Appellants respectfully submit that is improper

to combine the teachings of the Girard patent and the Wood application and that event the improper combination thereof fails to teach each element recited in independent claims 1, 8, and 19. As such, the Appellants respectfully submit that these claims and dependent claims 2-4, 10-14, and 16, which depend therefrom include all of the limitations thereof, are patentable and nonobvious over the Girard patent and the Wood application.

**B.     Claims 5 and 6 are Patentable Under 35 U.S.C. § 103(a)
         Over the Girard Patent, Wood Application and the Knee Patent**

        The Appellants respectfully submit claims 5 and 6, which depend from patentable independent claim 1, are patentable at least of the same reasons that claim 1 is patentable.

**C.     Claims 7 and 17 are Patentable Under 35 U.S.C. § 103(a)
         Over the Girard patent, the Wood application, and the Nishikawa Application**

        The Appellants respectfully submit claims 7 and 17, which depend from patentable independent claim 9, are patentable at least of the same reasons that claim 9 is patentable.

**D.     Claim 15 is Patentable Under 35 U.S.C. § 103(a)
         Over the Girard patent, the Wood application, the Vallone Patent**

        The Appellants respectfully submit claim 15, which depend from patentable independent claim 9, is patentable at least of the same reasons that claim 9 is patentable.

### E.  Claim 18 Is Patentable Under 35 U.S.C. § 103(a)
### Over The Girard Patent and Wood Application

This rejection applies to dependent claim 18, which depends directly from patentable independent claim 9, and is therefore patentable for at least the same reasons that claim 9 is patentable.  Moreover, the Appellants submit claim 18 is separately patent over Wood, Girard, Bertram, and Schneidewend.

Dependent claim 18 includes limitations directed towards the broadcast programming provided in claim 9 further including a data structure for providing a network address and rendering a bug on a television screen such that the bug can be selected by the user to communicate with the network component associated with the network address.

The Examiner asserts that the network address portion of this claim is not a limitation as it is recited in the preamble.  This is incorrect.  The preamble claim 18 is limited to the portion that states "A method according to claim 9."  The portions thereafter are not part of the preamble and are included as claim limitations.

Moreover, MPEP 2111.02 points out that "any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." (See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989))

The Examiner notes that Wood, Girard, and Bertram fail to teach a network address assigned to the network components, i.e., the portion recited in the so called preamble. Nonetheless, the Examiner submits Schneidewend makes up for this deficiency if the preamble is considered as a claim limitation.

The Appellants submit the Schneidewend patent fails to teach a data structure for providing a network address and rendering a bug on a television screen such that the bug can be selected by the user to communicate with the network component associated with the network address, as recited in claim 18.

The Schneidewend patent merely discloses a decoder that allows a user to easily select, tune, and acquire services from a number of elements. The Schneidewend patent fails to disclose the use of network addresses to select between the accessed services. Claim 18 requires the services (data) to be accessed as a function of network addresses associated with a bug displayed on a television screen. The Schneidewend patent fails to disclose this particular limitation.

Accordingly, claim 17 is patentable for at least the same reasons that independent claim 9, from which it depends, is patentable, and claim 18 is further separately patentable for the foregoing reasons.

**F.     Claims 19-20 and 26 Are Patentable Under 35 U.S.C. § 103(a)
        Over The Schneidewend And Bertram Patents and The Ozawa Application**

This rejection applies to independent claim 19 and dependent claims 20, 21, and 26, which depend therefrom and include all the limitations thereof. The Appellants submit the cited references fail to teach each element recited in independent claim 19.

In particular, independent claim 19 includes limitations directed towards providing a broadcast stream from a head-end. The broadcast stream including a network address and a bug for display on a television screen such that the bug can be selected to retrieve data from a database located remotely from the head-end as a function of the network address associated with the bug.

As described above with respect to claim 18, the Appellants submit that the Schneidewend patent fails to disclose communicating with remote network components as a function of a network address. Those arguments are hereby incorporated. Furthermore, the Appellants submit both of the Bertram and Ozawa references fail to teach accessing remote databases as a function of network addresses included within a broadcast stream, as recited in claim 18.

As admitted by the Examiner, Bertram fails to teach accessing remote databases as a function of network address. The Ozawa application merely teaches interfacing a settop box (STB) with an internet service provider (ISP). It fails to teach accessing the internet and associated internet components as a function of network addresses included within a broadcast television stream.

The Appellants point out that the mere capability of the cited references to execute particular elements of the present invention is not sufficient to render the claimed invention obvious. There must be some suggestion or motivation to do so. (see the MPEP citation provided above) There is simply no suggestion in any of the cited reference to interact with network components located remotely from a head-end as a function of a network address included within a broadcast stream provided by the head-end. The only such suggestion or motivation is provide by the Appellants' application.

For the foregoing reasons, the Appellants respectfully submit that the Schneidewend and Bertram patents and the Ozawa application fail to teach each element recited in independent claim 19. As such, the Appellants respectfully submit that independent claim 19 and dependent claims 20, 21, and 26, which depend therefrom include all of the limitations thereof, are patentable and nonobvious over the Schneidewend and Bertram patents and the Ozawa application.

**G.    Claims 22-24 are Patentable Under 35 U.S.C. § 103(a)
Over the Schneidewend patent, the Bertram patent, the Ozawa application, and
the Nishikawa patent**

The Appellants respectfully submit claims 22-24, which depend from patentable independent claim 19, are patentable at least of the same reasons that claim 19 is patentable.

**H.    Conclusion**

The Appeal Brief fee of $950.00 as applicable under the provisions of 37 C.F.R. § 41.20(b)(2) is enclosed with the two month extension fee of $450.00.  Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978.

Respectfully submitted,
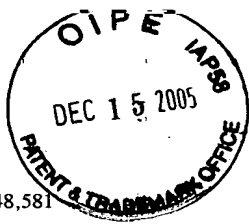
**James R. Durkee et al.**

By:_____
John R. Buser
Registration No. 51,517
Attorney/Agent for Applicant

Date: 12-12-05

**BROOKS KUSHMAN P.C.**
1000 Town Center, 22nd Floor
Southfield, MI  48075-1238
Phone:  248-358-4400
Fax:    248-358-3351

Enclosure - Appendices

## VIII. <u>CLAIMS APPENDIX</u>

1.     An interactive television network, comprising:

a data locator for locating data, the data locator being in communication with a set-top terminal for accessing interactive television network components and for providing broadcast programming to a subscriber through a television connected to the set-top terminal;

one or more memories located remotely from the data locator and in communication therewith through a network and containing at least three of the following data accessible by the data locator:

television listing data containing broadcast programming scheduling information relating to past, current, and future scheduled programming on the interactive television network;

programming content data containing audio and video content of previously broadcast programming on the interactive television network;

email data containing email for interactive television network subscribers; and

interactive television network subscriber voice mail database containing voice mail information for interactive television network subscribers' telephones.

2.     An interactive television network according to claim 1, wherein the television listing data includes for each program a title, a broadcast channel, a broadcast time, a broadcast duration, a program content description, a program rating, a program category, and another air time.

3.     An interactive television network according to claim 1, wherein the programming content data includes at least one of closed caption information, speech

transcription, video information, program tide, program rating, program category and another air time.

     4.    An interactive television network according to claim 1, wherein the programming content data includes at least one of metadata and XML data.

     5.    An interactive television network according to claim 1, wherein the one or more memories further include:

     billing data for interactive television network subscribers;

     help data to respond to questions of interactive television network subscribers;

     personal information for each interactive television network subscriber;

     calendar information for each interactive television network subscriber; and

     financial information for each interactive television network subscriber.

     6.    An interactive television network according to claim 5, wherein the personal information includes payment method, credit card information, debit card information, network subscriber's name, telephone number information, address information, and a history of purchases for each network subscriber.

     7.    An interactive television network according to claim 1, wherein the television includes a title safe portion and an action safe portion.

     8.    An interactive television network, comprising:

     a data location means for locating data, the data location means being in communication with a set-top terminal means for accessing other network components and for providing broadcast programming to an interactive television network subscriber through a television means connected to the set-top terminal for displaying programming;

     at least three of the following databases located remotely from the data locator and in communication therewith through a network and accessible by the data location means:

a television listing database containing broadcast programming scheduling information relating to past, current, and future scheduled interactive television network programming;

a programming content database containing audio and video content of previously broadcast programming on the interactive television network;

an email database containing email for interactive television network subscribers; and

a subscriber voice mail database containing voice mail information for interactive television network subscribers' telephones.

9.      A method for operating an interactive television network, comprising:

providing a data locator for locating the data, the data locator being in communication with a set-top terminal for accessing other network components and for providing broadcast programming to a subscriber through a television connected to the set-top terminal, and memory located remotely from the data locator and in communication therewith through a network and containing at least three of the following types of data accessible by the data locator:

television listing data containing broadcast programming scheduling information relating to past, current, and future scheduled interactive television network programming;

programming content data containing audio and video content of previously broadcast programming on the interactive television network;

email data containing email for interactive television network subscribers; and

subscriber voice mail data containing voice mail information for interactive television network subscribers' telephones;

receiving, with the set-top terminal, a request from an interactive television network subscriber;

communicating with the memory to retrieve one or more of the at least three types of the data; and

forwarding the at least three types of the data to the interactive television network subscriber.

10.    A method according to claim 9, further comprising:

recording at least a portion of the broadcast programming in the memory during the broadcast of the broadcast programming;

receiving one or more requests from network subscribers to rebroadcast the broadcast programming;

retrieving the broadcast programming from memory; and

replaying the broadcast programming from the memory to the one or more network subscribers to provide broadcast quality video to the one or more network subscribers.

11.    A method according to claim 9, wherein the communicating step includes searching through closed caption data, broadcast time, broadcast channel, a content category, content theme, and a content therein.

12.    A method according to claim 9, wherein the forwarding step includes providing only a portion of a program to the network subscriber.

13.    A method according to claim 12, wherein the program portion includes only a portion of the frames of the program.

14.    A method according to claim 9, wherein the forwarding step includes providing a location indicator of the at least three types of data to the network subscriber.

15.    A method according to claim 9, wherein the location indicator is a pointer to a time stamp in a multimedia stream.

16.    A method according to claim 9, further comprising:

receiving from the network subscriber an email message including the location indicator; and

delivering the email message to a second network subscriber.

17.    A method according to claim 9, further comprising:

displaying a virtual keyboard to the network subscriber, the virtual keyboard being located entirely in a title safe portion of the television screen; and

receiving from the network subscriber a signal corresponding to a key on the virtual keyboard.

18.    A method according to claim 9, wherein the broadcast programming includes a data structure providing a network address and further comprising:

rendering a bug on the television screen,

receiving, from the network subscriber, a signal associated with the bug; and

in response thereto, sending a signal to the network address.

19.    A method for using an interactive television network, comprising:

providing a multimedia broadcast stream to a set-top terminal from a head-end unit, the broadcast stream containing a network address;

rendering a first picture on a television containing at least one bug associated with the network address;

receiving a signal from an interactive television network subscriber relating to the bug;

accessing data stored on a database located remotely from the head-end unit in response to receipt of the signal and according to the network address, the network address being associated with the database located remotely from the head end unit; and

providing the remotely located data from the remote database to the head-end unit for delivery to the set-top terminal.

20.     The method of claim 19, further comprising:

rendering a second picture on the television presenting information related to the bug and the remotely located data.

21.     The method of claim 19, wherein the network address is at least one of a universal resource locator and a channel.

22.     The method of claim 19, wherein the multimedia broadcast stream includes an advertisement from a vendor.

23.     The method of claim 22, wherein the bug is rendered as a request to purchase a good or service in the advertisement.

24.     The method of claim 20, wherein the second picture includes a confirmation request.

25.     The method of claim 19, wherein the rendering step includes the steps of accessing a database containing personal information associated with the network subscriber, the database being maintained by a network operator, and including the retrieved personal information in the purchase information.

26.     The method of claim 19, further comprising:

connecting the subscriber with a vendor.

27.    The method of claim 20, further comprising prior to the rendering of the second picture:

retrieving personal information corresponding to the interactive television network subscriber from memory; and

completing at least one field, using the personal information, in an electronic order form associated with a vendor and wherein the completed at least one field is at least part of the information presented to the interactive television network subscriber in the second picture.

## IX.  <u>EVIDENCE APPENDIX</u>

**None**

# X.  <u>RELATED PROCEEDINGS APPENDIX</u>

**None**